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not teach nor fairly suggest nucleic acid compositions comprising the claimed SEQ ID NOS: in claim 3 nor the dependent claims 21-32.

(Office Action dated October 3, 2002, page 9; emphasis added). Thus, the Examiner instructed Applicants to rewrite claims 3 and 21-32 to gain allowance. In response to this objection, Applicants noted that the claims objected to by the Office as dependent on rejected base claims were, in fact, already presented in independent form.

Surprisingly, the following Office Action (mailed April 9, 2003), failed to even address the claims that had previously been indicated to be allowable.

Applicants respectfully assert that pursuant to MPEP § 707.07, each Office Action should be complete with respect to all matters. From the Office's apparent "change of mind" with respect to the allowed claims, it appears the Office is engaging in piecemeal prosecution by issuing a Restriction Requirement directed at all the pending claims after a substantive Office Action in which select claims were noted to be allowable. Applicants respectfully assert that such prosecution prejudices Applicants' rights, both by unduly extending prosecution, thereby shortening potential patent term, and by confusing the record of the prosecution to date. Further evidence of the prejudice imposed upon Applicants is that the Patent Office is now seeking Restriction/Election of the present invention including a requirement to elect a species of claim 3, a claim previously indicated to be allowable. Among the asserted reasons for requiring an election the Office notes that searching the entire scope of claim 3 would be unduly burdensome. As discussed in greater detail below, this statement is incredible as the Office specifically indicated that the claim had already been searched and found free of the art.

Applicants respectfully request an explanation for the piecemeal examination to date, and, in particular, justification for the apparent withdrawal from "allowable" status of claims 3 and 21-32.

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Restriction/Election Requirement

The Examiner required Applicants to elect "an antisense compound targeted to one (1) target region from claim 1 and an antisense oligonucleotide sequence from claim 3 that corresponds to the elected region of claim 1." (Office Action, page 5). Applicants respectfully traverse.

The Office alleged that "[a]lthough the antisense compounds claimed each target and modulate the expression of the same gene, the compounds targeting the recited target region sequences are considered to be unrelated, since each compound claimed is structurally and functionally independent and distinct . . .". The Office further alleges that a search of more than one of the antisense target regions recited in claim 1 would present an undue burden on the Patent and Trademark Office. The Office also alleged that the "antisense oligonucleotides recited in Claim 3 are restrictable for those reasons set forth above [referring to Claim 1]." (Office Action, page 3).

Applicants provisionally elect the 3'UTR of SEQ ID NO:3 from claim 1 and SEQ ID NO:76 from claim 3 for examination. Applicants note that claims 1-10, 12-14 and 21-32 read on the election of the 3'UTR species in claim 1. Claims 1-10, 12-14 and 21-32 read on the election of the SEQ ID NO:76 species in claim 3.

It is Applicants' understanding upon reviewing the present Office Action that claims 1 and 3 are considered to be linking claims. According to MPEP § 809,

The linking claims must be examined with the invention elected, and should any linking claim be allowed, the restriction requirement must be withdrawn. Any claim(s) directed to the nonelected invention(s), previously withdrawn from consideration, which depends from or includes all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability.

Accordingly, Applicants presume that the linking claims will be examined along with the invention elected.

Notwithstanding the foregoing, Applicants respectfully assert that the present Restriction/Election Requirement is moot with respect to claims 3 and 21-32. As discussed above, the Office has previously stated that "[t]he art does not teach nor fairly suggest nucleic acid compositions comprising the claimed SEQ ID NOS: in claim 3 nor

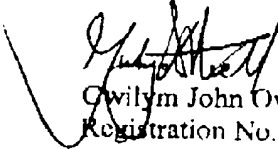
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the dependent claims 21-32. (Office Action dated October 3, 2002, page 9; emphasis added). As set forth in MPEP § 803, if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. As the Office has already searched and found claims 3 and 21-32 to be free of the art and allowable, the Office's present position that a search of the entire scope of claim 3 would impose a serious burden directly contradicts the Office Action dated October 3, 2002 – indeed, it appears that a search of the entire scope has already taken place. Accordingly, Applicants respectfully request withdrawal of the Election of Species Requirement upon reconsideration.

The examination of the pending claims and passage to allowance are respectfully requested. An early Notice of Allowance is therefore earnestly solicited. Applicants invite the Examiner to contact the undersigned at (215) 665-6904 to clarify any unresolved issues raised by this response.

Respectfully submitted,


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